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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,178	03/16/2001	Toyohisa Oya	2870-0164P	5742

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

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DATE MAILED: 01/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/809,178

Applicant(s)

OYA ET AL.

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5, 9, , 14-16 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Arai et al (Arai). See especially Arai in column 59, claim 1, compound A, and hydrazine derivative of formula (II) to (V) and the exemplified compounds in columns 11-30. The compound contains a phenyl groups within the scope of Q<sup>1</sup> (5- to 7-membered unsaturated ring),

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an acyl group, sulfonyl, aryloxycarbonyl or sulfamoyl group within the scope of R<sup>1</sup> of the claimed compound. Note also to the definition of R10, R11, R12 and R13 which includes heterocyclic group, aromatic group or an unsaturated heterocyclic group. Since the compound of the claimed invention is within the scope of the compound exemplified by Arai such as Q<sup>1</sup> group and an acyl group. The claimed invention is anticipated by Arai. Alternatively, it would have been obvious to the skill of ordinary skill to select the hydrazine compound within the scope taught in Arai to provide an invention as claimed. The hammet value presented in claim 3 is inherent to the hydrazine taught in Arai because of the similarity of its structure.

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arai as applied to claims 1,3, 5, 9, , 14-16 above, and further in view of Asanuma et al (Asanuma).

Asanuma discloses the use of the phthalazine derivative of the present claimed invention to minimize the drop of image density when stored under warm humid condition. See especially the phthalazine compound in columns 3-4. it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to include the phthalazine compound of Asanuma in the material of Arai for same reason, and thereby provide a material as claimed.

5. Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai as applied to claims 1,3, 5, 9, , 14-16 above, and further in view of Takeuchi.

TaKeuchi discloses a hydrazine of the claimed invention. see column 2, formula (I) and exemplified compound in column 5-21. It would have been expected to the worker of

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ordinary skill in the art that a hydrazine would behave similarly when used in similar heat developable composition, and therefore, the use of the hydrazine of Takeuchi in the material of Arai would have been found prima facie obvious to the worker of ordinary skill in the art at the time the invention was made.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arai as applied to claims 1,3, 5, 9, , 14-16 above, and further in view of Kato.

Kato discloses a use compound having functional group similar to that exemplified in the present disclosure and claimed in the present claimed invention as hydrogen bond-forming compound to provide a photothermographic material with rapid development see compound in columns 4-7. It would have been obvious to the worker of ordinary skill in the art to include the compound taught in Kato in the material of Arai for same reason, and thereby provide a material as claimed.

### **Conclusion**

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea *tl*  
January 25, 2002

  
Thorl Chea  
Primary Examiner  
Art Unit 1752